

REMARKS

Claims 1-9 and 11-15 are pending in the application. Claims 1-9 and 11-15 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.

Prior to amendment, the phrase at issue was that the 'control sheet could be located in a position *other than that of a cover sheet.*' The amendment was not intended to say that the control image was not on a cover sheet, but that the control sheet was located in *a position* other than that of a cover sheet. It seems that there is a lack of communication as to the ability to locate the cover sheet in a position other than the first page of an imaging job. Applicants were attempting to clarify that the cover sheet in their invention can be located somewhere beside the first page of the imaging job. Applicants have amended the claims to specifically state that, and this is supported in the specification at page 5, lines 14-23, for example. As the language objected to has been removed, withdrawal of this rejection is requested.

Claims 1-9 and 11-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention. There is no difference between a cover sheet for a document and a cover sheet for a facsimile. The determination of a cover sheet is within an imaging job, whether that imaging job be a document for OCR or several documents put together to be sent in one fax. The term objected to, the 'cover sheet' has been removed from the claim. Withdrawal of this rejection is requested.

Claims 1-9 and 11-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Schmid et al. (US Patent No. 5,659,164).

With regard to claims 1 and 8, there seems to be confusion as to the location of a cover sheet for a particular imaging job. In the invention as claimed, the control sheet, which is the sheet upon which the control image is located, is provided for an imaging job. See the specification, page 5. This cover sheet can be located within the imaging job, in a position other than the first page. See the specification, page 5, lines 14-18, or page 5, lines 19-21.

In Schmid, the cover sheet that is the sheet containing the control image occurs at the beginning of each job. The office action refers to Figure 1 as clearly showing 'that the cover page 1 is located at the different position with other pages of the document. This is a little unclear, but it seems to be saying that cover page 1 is located in positions other than the first page. However, it is shown in Figure 1 that COVER PAGE 1 is clearly located as the front page for that particular imaging job. COVER PAGE 1', which may be what is being referred

to, is not part of the imaging job. As discussed in the specification at column 4, lines 37-45, ‘when a *new* cover page is encountered, ... the previous page becomes the last page of the document and all pages are electronically “stapled” or assembled into *a single identifiable entity*...[emphasis added].’ It becomes apparent that COVER PAGE 1 is for a first imaging job of PAGE 1 through PAGE n + 1, and COVER PAGE 1’ is the cover page for a second imaging job comprised of PAGE 1’ through PAGE n + 1’. Therefore Schmid only teaches that a cover page and control image can only be located at a first page of the imaging job.

Therefore, it is submitted that the subject matter of claims 1 and 8 is patentably distinguishable over the prior art and allowance of these claims is requested.

With regard to claims 2-7 and claims 9 and 11-15 depend from claims 1 and 8, respectively, and should be ruled allowable for that reason and for their own merits.

With regard to claims 2 and 9, Schmid does not teach that the imaging job is an imaging acquisition task where the control sheet can be located at other than the first page of the imaging job.

With regard to claims 3 and 11, Schmid does not teach that the imaging job is an imaging production task where the control sheet can be located at other than the first page of the imaging job.

With regard to claims 4-6 and 12-14, Schmid does not teach that the control image that can be located at other than the first page of the imaging job can be machine readable, as in claims 4 and 12, text, as in claims 5 and 13, or numbers as in claims 6 and 14.

With regard to claims 7 and 15, Schmid does not teach that the second control image is for the same imaging job. This is supported in the specification on pages 7 and 8. It appears that the office action has either contradicted itself, or that the COVER PAGE 1’ is trying to be used to show two different things. In the comments above, with regard to claim 1, the office action stated that Figure 1 shows that COVER PAGE 1 was shown as being located anywhere within the document.

Applicants read the statements with regard to claim 1 and assumed the Examiner was referring to COVER PAGE 1’, as Figure 1 clearly shows COVER PAGE 1 as being the first page of the imaging job of PAGE 1 through PAGE n+1. If the intention was to show that a cover page could appear anywhere in an imaging job, based upon the location of COVER PAGE 1’, Applicants have addressed that with regard to claims 1 and 8 above. COVER PAGE 1’, used in the argument of claim 1 to show that the cover page could appear anywhere in the stack of documents, cannot then be used to show that a second control image is used.

COVER PAGE 1' cannot be both the cover page located anywhere and the second cover page.

If, however, the Examiner actually meant that Figure 1 shows COVER PAGE 1 in a position other than the first page, Applicants can only conclude that the Examiner is mistaken. Figure 1 clearly shows that COVER PAGE 1 is in the position of the first page and there is no indication that it can be otherwise.

The second control image of claims 7 and 15 are directed to a second control image for the same imaging job. As discussed above, the COVER PAGE 1' clearly delimits a new imaging job, and therefore is not for the same imaging job.

It is therefore submitted that claims 2-7, 9 and 11-15 are patentably distinguishable over the prior art and allowance of these claims is requested.

No new matter has been added by this amendment. Allowance of all claims is requested. The Examiner is encouraged to telephone the undersigned at (503) 222-3613 if it appears that an interview would be helpful in advancing the case.

Respectfully submitted,

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